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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/486,723

05/18/2000

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2431

7590 02/18/2009
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EXAMINER

PICH, PONNOREAY

ART UNIT

PAPER NUMBER

2435

MAIL DATE

DELIVERY MODE

02/18/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL LAMLA, HERMANN DREXLER, WOLFGANG
RANKI, FRANZ WEIKMANN, and WOLFGANG EFFING

Appeal 2008-1918
Application 09/486,723
Technology Center 2100

Decided: February 18, 2009

Before LANCE LEONARD BARRY, JEAN R. HOMERE, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-14. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

INVENTION

The invention at issue on appeal uses an external device to test the authenticity of a data carrier. (Spec. 16.)

ILLUSTRATIVE CLAIM

The following claim further illustrates the invention:

1. A method for testing the authenticity of a data carrier having an integrated circuit by an external device with which the data carrier exchanges data, comprising the steps of:

providing a first bidirectional transmission channel for transmitting signals having signal patterns between the data carrier and the external device,

providing a second bidirectional transmission channel logically separated from the first bidirectional transmission channel, the separation of the first and second bidirectional transmission channels being so designed that data transmission via one bidirectional transmission channel does not interfere with data transmission via the other bidirectional transmission channel and the second bidirectional transmission channel is activable [sic] during the total time period between activation and deactivation of the data carrier,

having the data carrier generate a signal required for authenticity testing,

transmitting the signal for authenticity testing from the data carrier to the external device or a signal required for generating the signal for authenticity testing from the external device to the data carrier at least partly via the second bidirectional transmission channel, and

having the external device receive the signal for authenticity testing, and deciding on the basis of the received signal whether the data carrier is authentic.

PRIOR ART

Saliba	5,894,425	Apr. 13, 1999
Ehrat	3,806,874	Apr. 23, 1974

REJECTION(S)

Claims 1, 8-10, 12, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Saliba.

Claims 1-4, 6-7, 11, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Saliba and Ehrat.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Saliba, Ehrat, and official notice.

"Rather than reiterate the positions of parties *in toto*, we focus on the issues therebetween." *Ex parte Katsukawa*, No. 2007-0732, 2007 WL 3043602 at *2 (BPAI 2007).

TWO TRANSMISSION CHANNELS

The Examiner finds that claim 1 "indicate[s] that the first channel was provided for a specific intended use, but there is no requirement that the first channel actually be used for that stated purpose." (Answer 15.) He also finds that Saliba's "[c]omputer . . . has several IR [i.e., infra-red] ports 24 which could provide first and second communication channels." (*Id.* at 18.) The Appellants argues that "there is only a single communication channel between the field unit 50 and a mass storage drives 16, 18, 20, 22, and another single communication channel between the field unit 50 and the remotely located host computer 60." (App. Br. 15.)

ISSUE

Therefore, the issue is whether the Appellants have shown error in the Examiner's finding that Saliba discloses two transmission channels, at least one of which connects a data carrier and an external device.

LAW

"[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)).

"An intended use or purpose usually will not limit the scope of the claim because such statements usually do no more than define a context in which the invention operates." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

FINDINGS OF FACT ("FFS")

1. Claim 1 recites in pertinent part the following limitations:

providing a first bidirectional transmission channel for transmitting signals having signal patterns between the data carrier and the external device,

providing a second bidirectional transmission channel . . .

. . . .

transmitting the signal for authenticity testing from the data carrier to the external device . . . at least partly via the second bidirectional transmission channel

2. The Appellants admit that Saliba's "computer 10 includes plural mass storage devices 16, 18, 20, 22 each having at least one bidirectional IR (infra-red) unit 24, wherein the IR unit 24 provides a secondary wireless IR bidirectional data port optically accessible by a device external to the computer (field unit 50)." (App. Br. 13.)

3. They also admit that "[s]eparately, the field unit 50 . . . includes a wireless radio send/receive unit 54, such as for cellular wireless communication, for communicating with a remote host computer 60. (see *Saliba*; col. 5, lines 44-46)." (*Id.* at 14.)

ANALYSIS

We agree with the Examiner that in the first clause of claim 1, the phrase "for transmitting signals having signal patterns between the data carrier and the external device" (FF 1), merely states an intended use or purpose for the claimed step of "providing a first bidirectional transmission channel" (*id.*). It does no more than define a context in which the invention operates. Giving the claim the broadest, reasonable construction, the aforementioned limitations (*id.*) merely require two transmission channels, at least one of which connects a data carrier and an external device.

Each of Saliba's mass storage devices features a bidirectional IR port optically accessible by the external field unit 50. (FF 2.) We agree with the Examiner's finding that the optical path between each of these IR ports and the field unit constitutes a transmission channels connecting the associated data carrying mass storage device to the external field unit.

We are unpersuaded by the Appellants' following argument.

Since the only potential communicating partner for the IR send/receive units 24 of the mass storage drives 16, 18, 20, 22 of the computer 10 is the field unit 50, and the field unit 50 possesses a single IR send/receive unit, there is no teaching or suggestion of the separate first and second communication channels required by the claims.

(App. Br. 17.) Although the optical paths between each of the IR ports and the field unit may share one common terminus, viz., the field unit, each path still constitutes a separate transmission channel.

Assuming *arguendo* that the optical transmission channels between each of the IR ports and the field unit were collectively interpreted as a single optical channel, the field unit also includes a wireless radio send/receive unit for communicating with the remote host computer. (FF 3.) We agree with the Examiner's finding that the cellular path between the radio unit and the field unit constitutes a transmission channel. The cellular path and the optical path collectively constitute two transmission channels' the latter channel connects at least one data carrying mass storage device to the external field unit.

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's finding that Saliba discloses two transmission channels, at least one of which connects a data carrier and an external device. Rather than arguing the rejections of claims 2-14 separately, they rely on their aforementioned arguments. Therefore, we sustain the Examiner's rejection of these claims for the same reasons detailed for independent claim 1.

COMBINING SALIBA AND EHRAT

The Examiner makes the following findings:

One skilled would have been motivated to modulate the IR channel to achieve two logically separated bidirectional channels because it would allow the PDA [i.e., personal data assistant] to communicate with more than one storage devices located in computer 12 at the same time, thus information could be gathered more quickly from the storage devices and updates could be uploaded to the storage devices more quickly. Likewise, one skilled would have been motivated to modulate the radio/cellular channel into two logically separate bidirectional channels at the same time because then the PDA would be able to communicate with two separate host devices at the same time. This allows the PDA to obtain further information from host devices more quickly and relay information from the storage device for further analysis more quickly.

(Answer 10.) The Appellants make the following argument:

[T]here is no reason for a person skilled in the art to turn to the teachings of such an identification unit as a source of communication methods to be applied in a system such as

Saliba, wherein limitation of range between the PDA and the mass storage device would hamper a technician's accessibility to the mass storage device, and limitation of the cellular communication to the remotely located host computer is clearly undesirable.

(Appeal Br. 21.)

ISSUE

Therefore, the issue is whether the Appellants have shown error in the Examiner's proposed combination of teachings from *Saliba* and *Ehrat*.

LAW

"What appellants overlook is that it is not necessary that the inventions of the references be physically combinable to render obvious the invention under review." *In re Sneed*, 710 F.2d 1544, 1550 Fed. Cir. 1983 (citing *Orthopedic Equip. Co. v. United States*, 702 F.2d 1005, 1013 (Fed. Cir. 1983); *In re Andersen*, 391 F.2d 953, 958 (CCPA 1968)); *see also In re Nievelt*, 482 F.2d 965, 968 (CCPA 1972) ("Combining the *teachings* of references does not involve an ability to combine their specific structures."). The test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference but what the combined teachings of those references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

FINDING OF FACT

4. The Examiner concludes that "it would have been obvious to one skilled in the art in light of *Ehrat*'s teachings to modify *Saliba*'s invention according to the limitations recited in claim 1 by modulating either the

radio/cellular channel or the IR channel into two logically separate bidirectional channels." (Answer 10.)

ANALYSIS

Here, the Examiner does not assert that any range limitation of Ehrat be bodily incorporated into the structure of Saliba. Instead, he asserts that the combined teachings of the references would have suggested to one of ordinary skill in the modulating Saliba's radio/cellular channel or IR channel into two logically separate bidirectional channels. (FF 4.) The Appellants argument overlooks "the relevant combined teachings of the two references." *In re Andersen*, 391 F.2d 953, 958 (CCPA 1968) (dismissing the argument that a combination would result in an inoperative structure).

CONCLUSION

Based on the aforementioned facts and analysis, we conclude that the Appellants have shown no error in the Examiner's proposed combination of teachings from Saliba and Ehrat.

ORDER

We affirm the rejections of claims 1-14.

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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